

REMARKS

Claims 1-5 were pending in the Application. Applicants cancelled claims 1-3 without prejudice or disclaimer. Hence, claims 4-5 are pending in the Application. Applicants cancelled claims 1-3 only to expedite the issuance of claims 4-5 and not in response to the Examiner's cited art. Applicants are not conceding in this application that cancelled claims 1-3 are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating the expeditious prosecution of the subject matter (claims 4-5) indicated by the Examiner as being allowable (see below). Applicants respectfully reserve the right to pursue these (claims 1-3) and other claims in one or more continuation patent applications.

Claim 4 was amended to be rewritten in independent form. Claim 5 was amended to be dependent upon claim 4 instead of cancelled claim 3. Hence, claim 5 was amended to be commensurate with the cancellation of claim 3.

Thus, no prosecution history estoppel arises from the amendments to claims 4 and 5. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 4 and 5 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. See *Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicants thank Examiner Schmidt for discussing the rejection of claim 4 on June 9, 2008 with Applicants' attorney, Bobby Voigt. Examiner Schmidt agreed to allow claims 4-5, with the present claim amendments, as discussed herein, provided that the Examiner does not find new relevant art in a subsequent search.

As was discussed with Examiner Schmidt on June 9, 2008, the rejections under 35 U.S.C. §103(a) in connection with pending claims 4-5 are overcome based on, at least in part, in the arguments presented herein.

Applicants respectfully assert that Hershey et al. (U.S. Patent No. 5,414,833) (hereinafter "Hershey"), Lingafelt et al. (U.S. Patent Application Publication No.

2004/0199790) (hereinafter "Lingafelt"), and Kodashiro (U.S. Patent No. 5,831,997), taken singly or in combination, do not teach "ID selection circuitry for selecting a match ID from ID data identifying the M PUs in response to a pattern match signal and match mode data, wherein the match ID and match data corresponding to the match ID are saved in a temporary register as the output data" as recited in claim 4.

The Examiner cites Figures 1A and 1B as well as column 10, lines 41-66; and column 14, line 40 – column 15, line 42 of Hershey as teaching the above-cited claim limitations. Office Action (4/9/2008), pages 8-9. Applicants respectfully traverse.

Hershey instead teaches that the active monitor is the programmability of the FSMs and the programmability of their interconnection, where each FSM consists of an address register and a memory. Column 10, lines 45-48. Hershey further teaches that the address register has two portions, an n-X bit wide first portion and a X-bit wide second portion X. X is one bit for binary data, X is a word of two bits for Manchester encoded data, or X is a word of five bits for FDDI encoded data. Column 10, lines 48-52. Furthermore, Hershey teaches a processor 102 including a memory 104 that includes a bit stream partition 124, and a plurality of task partitions, where each task partition includes a start partition 202, an address register partition 134, and a matrix partition 132. Column 14, lines 40-45.

Hence, Hershey teaches the programmability of finite state machines (FSMs) and the programmability of their interconnections, where each FSM includes an address register and a memory. Hershey further teaches a processor that includes a memory that includes a bit stream partition.

There is no language in the cited passages that teaches ID selection circuitry for selecting a match ID from ID data identifying the M PUs. Neither is there any language in the cited passages that teaches ID selection circuitry for selecting a match ID from ID data identifying the M PUs in response to a pattern match signal and match mode data. Neither is there any language in the cited passages that teaches that the match ID and match data corresponding to the match ID are saved in a temporary register. Neither is there any language in the cited passages that teaches that the

match ID and match data corresponding to the match ID are saved in a temporary register as the output data.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 4, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claim 5 recites the combinations of features of independent claim 4, and hence claim 5 is patentable over Hershey in view of Lingafelt and in further view of Kodashiro for at least the above-stated reasons that claim 4 is patentable over Hershey in view of Lingafelt and in further view of Kodashiro.

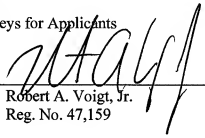
As a result of the foregoing, it is asserted by Applicants that claims 4-5 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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